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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hiroshi Nitta

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STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

VAN BRAMER, JOHN W

ART UNIT

PAPER NUMBER

3622

MAIL DATE

DELIVERY MODE

01/04/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/919,844	Applicant(s) NITTA ET AL.	
	Examiner JOHN VAN BRAMER	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-9,12-15 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-9,12-15 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 2, 2009 has been entered.

Response to Amendment

2. The amendment filed October 2, 2009 cancelled claims 19, 22, and 23. Claims 1-3, 6, 7, 9, 13, and 15 have been amended and no new claims have been added. Thus the currently pending claims remain Claims 1-3, 6-9, 12-15, and 18.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 6-9, 12-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino (U.S. Patent Number: 4,648,037) in view of Kramer et al. (U.S. Patent Number: 6,327,574).

Claim 1: Valentino discloses an information inquiry apparatus that receives information inquiry of a user from a terminal connected through a communication pathway and that receives advertising information of a product, including pricing data and/or an advertisement link that allows access to additional advertising information, from an advertising company, the information inquiry apparatus, comprising:

- a. an electronic data storage device that stores the inquiry information of the user, and an advertisement information file that stores the advertising information. (Col 4, lines 25-38; Col 5, lines 12 – 22; and Col 6, lines 49 through Col 7, lines 21)
- b. A computer processor that executes retrieval of user information according to the information inquiry of the user. (Col 11, lines 1-40)
- c. An inquiry image display generator that generates and transmits display data from the inquiry information file so that a display image of the display data contains the retrieved user information. (Col 6, line 49 through Col 7, line 21)
- d. A purchase simulator that simulates for the advertising company a purchase of the advertising company product based upon the retrieved user information and the received advertising information including the pricing data. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to

include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 2: Valentino and Kramer disclose the information inquiry apparatus in claim 1, wherein the computer processor further executes storing in the electronic data storage device a confirmation information file that stores confirmation information when the user submits the information inquiry from the terminal and the user receives the display image. (Valentino: Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 3: Valentino and Kramer disclose the information inquiry apparatus in claim 2, wherein the user is an employee of an organization and confirmation information is sent to the organization. (Valentino: Col 5, lines 49 – 64 and Col 14, lines 34 – 44)

Claim 6: Valentino and Kramer disclose the information inquiry apparatus in claim 1, wherein the user is an employee of an organization and the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 7: Valentino discloses an employee information communication method, comprising:

- a. Electronically storing employee information of an organization including at least one of employee name, employee company, employee number and employee password. (Col 4, liens 25-38; Col 5, lines 12 – 22; Col 6, lines 49 through Col 7, lines 21; and Col 13, line 52 through Col 14, line 65)
- b. Electronically storing advertising information of a product, including pricing and/or an advertisement link that allows access to additional advertising information from an advertising company. (Col 4, liens 25-38; Col 5, lines 12 – 22; Col 6, lines 49 through Col 7, lines 21; and Col 13, line 52 through Col 14, line 65)
- c. Electronically storing employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from the organization. (Col 13, lines 52 – 67)
- d. Receiving an inquiry from an employee of the organization. (Col 14, lines 19 – 33)
- e. Generating and transmitting to the employee a detailed wage image that includes the advertising information, the employee information and the employee detailed wage information. (Col 14, lines 19 – 33)
- f. Simulating on behalf of the organization and the advertising company a purchase of the advertising company product based upon the employee detailed wage information of the organization and the advertising information including the pricing data.. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to

include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 8: Valentino and Kramer disclose the employee information communication method in claim 7, further comprising electronically storing confirmation information when the employee submits the inquiry and receives the detailed wage image. (Valentino: Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 9: Valentino and Kramer disclose the employee information communication method in claim 8, further comprising sending the confirmation information to the organization. (Valentino: Col 5, lines 49 – 64; and Col 14, lines 34 – 44)

Claim 12: Valentino and Kramer disclose the employee information communication method in claim 7, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Claim 13: Valentino discloses an employee information communication system, comprising:

- a. A first electronic data storage device that stores employee information of an organization including at least one of employee name, employee company,

- employee number and employee password. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
- b. A second electronic data storage device that stores advertising information of a product including pricing and/or an advertisement link that allows access to additional advertising information, from an advertising company. . (Col 4, liens 25-38; Col 5, lines 12 – 22; Col 6, lines 49 through Col 7, lines 21; and Col 13, line 52 through Col 14, line 65)
 - c. A third electronic data storage device that stores employee detailed wage information including at least one of employee number, employee company, employee name, payment amounts, deduction amounts and date of payment from the organization. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
 - d. An image generator that receives an inquiry from an employee of the organization, and generates and transmits to the employee a detailed wage image that includes the advertising information, the employee information and the employee detailed wage information. (Col 4, line 61 through Col 5, line 11; Col 6, line 49 through Col 7, line 21; and Col 13, lines 52 – 67)
 - e. A purchase simulator of the organization that simulates for the advertising company a purchase of the advertising company product based upon the employee detailed wage information of the organization and the advertising information including the pricing data. (Col 14, line 45 through Col 15, line 23)

The Valentino reference discloses that the information requested by the employee includes such information related to possible choices in their retirement plans, health insurance plans, and flexible benefit plans such as cafeteria plans. While these choices are enticements to purchase the displayed products, and therefore qualify as advertisements, Valentino does not specifically state that these are advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner. However, the analogous art of Kramer (U.S. Patent Number: 6,327,574), discloses that any structured document may be illuminated with advertisements (Col 7, lines 45-53; Figs 3A and 3B). An illumination is a piece of targeted content (Col 4, lines 64-67) whereby sections of documents annotated or replaced with targeted content that expands upon the information in the original content and provides a more interesting presentation of the information (Col 6, lines 23-46) including hyperlinks and promotions (Col 7, lines 8-28). The illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy (Col 11, line 55 –67) and data regarding the success of the promotion such as the number of views is sent to the advertisers server (Col 13, lines 26-53). Therefore, it would have been obvious to one of ordinary skill in the art to use the targeted advertising disclosed by Kramer with the apparatus for benefit and financial communication disclosed by Valentino. One would have been motivated to

include such advertising in order to provide an advertisement revenue stream that helps to offset the expense of operating the system disclosed by Valentino.

Claim 14: Valentino and Kramer disclose the employee information system in claim 13, further comprising a fourth electronic data storage device that stores confirmation information when the employee submits the inquiry and receives the detailed wage image. (Valentino: Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 15: Valentino and Kramer disclose the employee information system in claim 14, wherein the confirmation information is sent to the organization. (Valentino: Col 5, lines 49 – 64: and Col 14, lines 34 – 44)

Claim 18: Valentino and Kramer disclose the employee information apparatus in claim 13, wherein the advertising information includes information tailored to at least one of an employee income level, an employee organizational unit and an employee information input. (Valentino: Col 14, lines 45 – 65)

Response to Arguments

5. Applicant's arguments filed October 2, 2009 have been fully considered but they are not persuasive.

a. The applicant argues that the claim as amended overcomes the Valentino and Kramer references because the presently amended claims which indicate simulating for an advertiser a purchase of a product advertised by the advertiser based upon user information and providing a product promotion analysis based upon the purchase simulation to the advertiser of the product. However, the Valentino reference specifically discloses simulating a purchase of the advertising company product based upon the employee detailed wage information of the organization and the advertising information including pricing data when it is discloses that "what if" scenarios are performed on the products being offered to the employees. Whether the reason for the simulation is for an employee, for the organization, or for the advertising company is merely an indication of intended use and as such is given little if any patentable weight. The simulation disclosed by Valentino can benefit the employee by providing options that the employee can select from and it can benefit the advertiser by enabling the employee to become aware of the advertisers options within the plan and thus can be "for" either and/or both the employee and the advertising company or even for the organization itself. The claimed product promotion analyzer currently is claimed as computing a product promotion result of the advertising information based upon the purchase simulation. It is important to note that the claimed "product promotion result" is not currently limited to be the items simulated in the purchase simulator, but rather it is based on the purchase simulation. As such an promotion displayed during the operation of the purchase

simulator will satisfy the product promotion analyzer step. As such when Kramer discloses providing promotions on a structured document such as the simulated what if page of Valentino, and then analyzes the results of those promotions and sends the results to the advertising company, the current limitations of the claims have been met. If the applicant is having trouble understanding the distinction made by the examiner, the examiner is more than willing to conduct a telephone interview to discuss the issues.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300'

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Van Bramer/
John Van Bramer
Examiner, Art Unit 3622